

**REMARKS****Status of Claims**

The Office Action mailed February 18, 2005 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-26 were pending in the application with claims 7-10, 17-20, 22, and 23 being withdrawn from consideration. Claims 1, 3-5, 11-16, 21, and 24-26 have been amended, withdrawn claims 7-10, 17-20, 22, and 23 have been cancelled and no claims have been newly added. Therefore, claims 1-6, 11-16, 21, and 24-26 are submitted for reconsideration. Applicants respectfully request entry of, and reconsideration based on, the instant amendment and reply because it is believed to place the application in condition for allowance or at the very least reduce the number of potential issues in an appeal.

This Amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

**Rejection under §112, second paragraph**

In the office action, claims 1-6, 11-16, and 21-23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended the claims to address the issues raised in paragraphs 6.a and 6.b of the office action.

With respect to the issue raised in paragraph 6.c, applicants note that the claim recitation in then pending claims 24-26 (and similar recitation in presently pending independent claims 1, 11, and 21 clearly defined what the applicants regarded as their invention wherein the sponsor determined auction parameter defined in these claims did not include winning bid information (or any bid information derived from an input received from any auction participant in the currently pending independent claims 1, 11, and 21). In paragraph 6.c, the office action states that “it is unclear how the [a] bid may not necessarily be a winning bid since this is usually determined after the auction is over.” (emphasis added). However, how this relates to the claim language of the earlier claims 24-26 is not clear since

the emphasized portion was neither recited nor implied by the earlier claims 24-26.

Therefore, clarification is respectfully requested with respect to 6.c in the office action.

With respect to the pending features recited in the pending independent claims, as noted in the MPEP §2173.01, “[a]pplicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.” Accordingly, since the pending claims make clear the boundaries of the subject matter for which protection is sought, applicants respectfully submit that the pending claims are in definite form and meet the requirements of § 112, second paragraph.

#### **Claim Interpretation Issues**

Applicants do not agree with the statement in paragraph 15 of the office action, that functional language is entitled to less patentable weight or that the pending claims recite subject matter using functional language. As stated in MPEP 2173.05(g), “[a] functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).” Accordingly, applicants believe that each recited element in the pending claims is entitled to patentable weight.

Furthermore, in the context of computer implemented inventions, as in the case of the present application, MPEP 2106 states that “[f]unctional descriptive material is a limitation in the claim and must be considered and addressed in assessing patentability under 35 U.S.C. 103. Thus, a rejection of the claim as a whole under 35 U.S.C. 103 is inappropriate unless the functional descriptive material would have been suggested by the prior art.” *See In re Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Applicants agree with the statement in paragraph 16 of the office action that none of these claims invoke the provisions of section 112, sixth paragraph.

With respect to the examiner's conclusions in paragraphs 13 and 14, applicants agree with the broadest *reasonable* interpretation standard as specified in MPEP 2111 and the current status of the case law. However, applicants do not necessarily agree with the remaining factual conclusions of the examiner. Furthermore, with respect to the standard for claim interpretation, as stated in MPEP 2111 and *In re Morris*, "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification." (emphasis added). Accordingly, even if the examiner's conclusion is correct that applicant has not acted as a lexicographer (with special definitions), the specification remains relevant to interpreting the claims from the perspective of one skilled in the art.

### **Prior Art Rejections**

In the Office Action, claims 1-6, 11-16, and 21-23 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. patent 6,199,050 to Alaia et al. (hereafter "Alaia"). Claims 1-6, 11-16, and 21-23 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 6,023,685 to Brett et al. (hereafter "Brett '685"). Claims 1-6, 11-16, and 21-23 are alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over Alaia. Applicants respectfully traverse these rejections for at least the following reasons.

Each of the independent claims 1, 11, and 21 recite that, *inter alia*, a computer implemented method (or software/system) that (1) determines whether a sponsor determined auction parameter generated by the sponsor of the auction has been changed, wherein the sponsor determined auction parameter is defined to exclude bid information derived from input from any auction participant; and (2) automatically refreshing a representation of the auction at a browser of an auction participant if it is determined that the sponsor determined auction parameter has been changed. The sponsor determined auction parameters are described in the specification, for example, at paragraphs 41 and 49, while the automatic

refreshing of a representation of a browser is described, for example, with respect to elements 340-380 in figure 3 and its description in the text of the specification. These recited features are not disclosed or suggested by the applied prior art.

Specifically, as stated in the office action, the only automatic update that may be suggested by Alaia relates to refreshing of bid information (for example, a winning bid information). Furthermore, even this bid information is not refreshed automatically (i.e., without a refresh manually originated by a participant's browser). If the examiner maintains that the automatic refresh of the browser is shown, applicants respectfully requests the examiner to indicate where in Alaia such a feature is shown. Clearly, a manual refresh or other participant initiated refresh is not an automatic refresh as recited in the independent claims. Therefore, even under the broadest reasonable interpretation of the pending claims, Alaia does not disclose or suggest the features recited in the pending claims.

Likewise, Brett discloses updating standing bid information for ticket information but does not disclose (1) determining whether a sponsor determined auction parameter has changed (not including bid information derived from input from any auction participant) and (2) automatically refreshing a participant browser when it is determined that the sponsor determined auction parameter has changed. Once again, a manual refresh or other participant initiated refresh is not an automatic refresh as recited in the pending claims. Accordingly, Brett does not disclose or suggest the features recited in the pending independent claims.

The dependent claims are also in condition for allowance for at least the same reasons, as discussed above, as the independent claims on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole. For example, claims 3 and 13 recite the specifics of an updater object for indicating that a sponsor determined auction parameter has changed and facilitating the automatic refresh of a participant browser. Such an updater object is also not disclosed or suggested by the applied prior art and provides an additional reason for the patentability of these claims.

**Conclusion**

Applicants respectfully request entry and reconsideration of the instant amendment and reply because it is believed to place the application in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

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